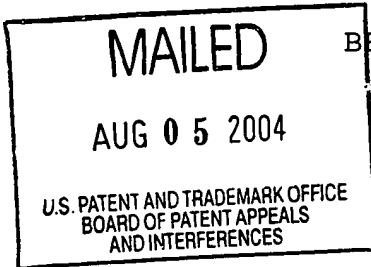


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte JUKKA HAAPANIEMI  
and  
MARKKA JARVINEN

Application No. 09/367,108

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on July 21, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

Appellants filed an Information Disclosure Statement (IDS) on February 12 2002 (Paper No. 9). It is not clear from the record whether the examiner considered the statement submitted or whether the examiner notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

On September 2, 2003, appellants filed a Reply Brief (Paper No. 19). The examiner filed a Supplemental Examiner's Answer in response to appellants' Reply Brief on December 2, 2003 (Paper

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response to appellants' Reply Brief on December 2, 2003 (Paper No. 21). According to § 1208.03 of the Manual of Patent Examining (8th ed., August 2001):

Under 37 CFR § 1.193(b)(1), appellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner's answer or supplemental examiner's answer. . . . The primary examiner must then either: (A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90 or (B) reopen prosecution to respond to the reply brief. See MPEP § 1208.02. A supplemental examiner's answer is not permitted unless the application has been remanded by the Board for such purpose.

. . . .

While 37 CFR 1.193(b)(1) prohibits a supplemental examiner's answer (in the absence of a remand from the Board of Patent Appeals and Interference[s] for such purpose), an examiner may (with supervisory patent examiner approval) respond to a reply brief by reopening prosecution.

A review of the application that the examiner has improperly responded to appellants' Reply Brief (Paper No. 19) by issuing a Supplemental Examiner's Answer. Since the Board did not remand this application for a Supplemental Examiner's Answer, this paper is improper. The Supplemental Examiner's Answer mailed on December 2, 2003 (Paper No. 21) needs to be vacated, and a proper response to appellants' Reply Brief needs to be issued by the examiner.

Accordingly, it is

ORDERED that the application is returned to the examiner for:

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(1) consideration of the IDS filed February 12, 2002 (Paper No. 9),

(2) notification to appellants in writing of said consideration of the IDS,

(3) vacating the Supplemental Examiner's Answer mailed December 2, 2003 (Paper No. 21);

(4) properly responding to appellants' Reply Brief filed September 2, 2003 (Paper No. 19) by either acknowledging receipt and entry using form paragraph 12.47 on form PTOL-90, or by reopening prosecution to respond to the reply brief, and

(5) for such further action as may be appropriate.

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AND INTERFERENCES

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DMS/clm/lrc  
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